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09/753,685	01/04/2001	John B. Ferber	08011.3000-00000	1659

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EXAMINER
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BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/753,685

**Applicant(s)**

FERBER, JOHN B.+

**Examiner**

Igor Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26,28-33 and 35 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-26,28-33 and 35 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/04/2000 has been entered.

***Response to Amendment***

Amendment received on 11/04/2004 is acknowledged and entered. Claims 27 and 34 have previously been canceled. Claims 1, 11, 17, 22 and 29 have been amended. Claims 1-26, 28-33 and 35 are currently pending in the application.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 2, 4-5, 8-11, 13-14, 16-17, 19, 21-26, 28-33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chern et al. (US 6,381,465) (Chern) in view of Angles et al. (US 5,933,811) (Angles).**

**Independent Claims**

**Claims 1 and 11.** Chern teaches a method and system for transmitting advertisements to cell phones, said system including an Internet provider server and advertisement server; said method comprising: obtaining user information stored in the handset memory (registering step), said information related to the user, user's

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preferences and handset (C. 8, L. 37-41); identifying a location of the handset (C. 8, L. 54-57); receiving an advertisement message from the advertisement server, and sending said advertisement message to the handset, wherein said advertisement message is based upon the identified location of the handset (C. 13, L. 43-50).

Chern does not specifically teach remunerating users for accepting the advertising messages.

Angles teaches a method and system for delivering customized advertisements within interactive communication environment, wherein registered users are paid for accepting advertisement messages transmitted to registered users terminals (C. 16, L. 35-37), and wherein said transmitted advertisement messages are based upon users profiles (C. 3, L. 19-25, 54-61).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern to include remunerating users for accepting the advertising messages, as disclosed in Angles, because it would advantageously stimulate users to receive more advertisement messages, thereby potentially increase sales and revenue.

**Claim 17.** Chern teaches said method and system for transmitting advertisements to cell phones, comprising: providing a server and database for storing the retrieved "user information", said information related to the user, user's preferences and handset (number) (C. 8, L. 37-41; 44-45); identifying a location of the handset (C. 8, L. 54-57); receiving an advertisement message from the advertisement server, and sending said advertisement message to the handset (cell phone), wherein said advertisement message is based upon the identified location of the handset and said "user information" (C. 13, L. 43-50).

Chern does not specifically teach remunerating users for accepting the advertising messages.

Angles teaches a method and system for delivering customized advertisements within interactive communication environment, wherein registered users are paid for accepting advertisement messages transmitted to registered users terminals (C. 16, L.

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35-37), and wherein said transmitted advertisement messages are based upon users profiles (C. 3, L. 19-25, 54-61).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern to include remunerating users for accepting the advertising messages, as disclosed in Angles, because it would advantageously stimulate users to receive more advertisement messages, thereby potentially increase sales and revenue.

**Claim 22.** Chern teaches said method and system for transmitting advertisements to cell phones, comprising: identifying a location of the handset (C. 8, L. 54-57); receiving advertisement messages from the advertisement server (C. 13, L. 43-50); and sending said advertisement message to the handset (cell phone), wherein said advertisement message is based upon the identified location of the handset (C. 13, L. 43-50).

Chern does not specifically teach remunerating users for accepting the advertising messages.

Angles teaches a method and system for delivering customized advertisements within interactive communication environment, wherein registered users are paid for accepting advertisement messages transmitted to registered users terminals (C. 16, L. 35-37), and wherein said transmitted advertisement messages are based upon users profiles (C. 3, L. 19-25, 54-61).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern to include remunerating users for accepting the advertising messages, as disclosed in Angles, because it would advantageously stimulate users to receive more advertisement messages, thereby potentially increase sales and revenue.

**Claim 29.** Chern teaches said method and system for transmitting advertisements to cell phones, comprising: identifying a location of the registered handset (C. 8, L. 37-41; 54-57); and sending advertisement messages to the handset (cell phone), wherein said advertisement message is based upon the identified location of the handset (C. 13, L. 43-50).

Chern does not specifically teach remunerating users for accepting the advertising messages.

Angles teaches a method and system for delivering customized advertisements within interactive communication environment, wherein registered users are paid for accepting advertisement messages transmitted to registered users terminals (C. 16, L. 35-37), and wherein said transmitted advertisement messages are based upon users profiles (C. 3, L. 19-25, 54-61).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern to include remunerating users for accepting the advertising messages, as disclosed in Angles, because it would advantageously stimulate users to receive more advertisement messages, thereby potentially increase sales and revenue.

#### Dependent Claims

**Claims 2 and 16.** Angles teaches receiving payment from the advertisers for sending the advertising messages (C. 21, L. 20-24). The motivation to combine Chern and Angles would be to stimulate users to receive more advertisement messages, thereby potentially increase sales and revenue.

**Claims 4 and 19.** Angles teaches said method and system, wherein consumers are remunerated incentives as part of a bonus program for accepting the advertising messages (C. 20, L. 32-35). The motivation to combine Chern and Angles would be to stimulate users to receive more advertisement messages, thereby potentially increase sales and revenue. Information as to *additional air-time* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that

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cannot alter how the process steps are to be performed. The method steps, disclosed in Chern in view of Angles would be performed the same regardless of the content or value of said incentives/bonuses.

**Claim 5.** Angles teaches receiving monetary compensation for accepting the advertising messages (C. 21, L. 20-24). The motivation to combine Chern and Angles would be to stimulate users to receive more advertisement messages, thereby potentially increase sales and revenue.

**Claim 8.** Angles teaches said method and system, wherein registering the wireless devices to receive advertising messages includes providing demographic information of a user of the wireless device (C. 3, L. 19-29). The motivation to combine Chern and Angles would be to potentially increase sales and revenue by providing users with advertising closely matching their interests.

**Claims 9 and 14.** Chern teaches said method and system, including the advertising server (C. 13, L. 44-47). Information as to *second* database is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

**Claims 10 and 21.** Angles teaches that user's access charges are reduced each time the user views a customized advertisement (C. 21, L. 23-24). The motivation to combine Chern and Angles would be to stimulate users to receive more advertisement messages, thereby potentially increase sales and revenue.

**Claim 13.** Angles teaches said system including registration means (C. 3, L. 19-29). The motivation to combine Chern and Angles would be to stimulate users to receive individually tailored advertisement messages, thereby potentially increase sales and revenue.

**Claims 23 and 30.** Chern teaches said method and system, wherein said advertising messages are text messages (Fig. 16).

**Claims 24 and 31.** Angles teaches said method and system, wherein consumers are remunerated incentives as part of a bonus program for accepting the advertising

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messages (C. 20, L. 32-35). The motivation to combine Chern and Angles would be to stimulate users to receive more advertisement messages, thereby potentially increase sales and revenue. Information as to *additional air-time* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Chern in view of Angles would be performed the same regardless of the content or value of said incentives/bonuses.

**Claims 25 and 32.** Angles teaches receiving monetary compensation for accepting the advertising messages (C. 21, L. 20-24). The motivation to combine Chern and Angles would be to stimulate users to receive more advertisement messages, thereby potentially increase sales and revenue.

**Claims 26 and 33.** Chern teaches said method and system, wherein said advertising message is a coupon (C. 1, L. 13).

**Claims 28 and 35.** Angles teaches that user's access charges are reduced each time the user views a customized advertisement (C. 21, L. 23-24). The motivation to combine Chern and Angles would be to stimulate users to receive more advertisement messages, thereby potentially increase sales and revenue.

**Dependent Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chern in view of Angles and further in view of Atsmon et al. (US 6,607,136) (Astomon).**

**Claim 3.** Chern in view of Angles teach all the limitations of claim 3, including paying the users as a bonus for accepting said advertisement messages (Angles; C. 20,



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L. 32-35), except specifically teaching that said remunerating includes: remunerating points for accepting said advertisement messages.

Astmon teaches a method for interacting with a broadcast media (TV or PC) to receive coupons and sales special offers, wherein users receive incentive points as a reward for watching advertisement (C. 55, L. 31-34).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern and Angles to include awarding the users with incentive points as a reward for watching advertisement, as disclosed in Astmon, because without providing indication in the specification the advantages of using said *points* over the teachings of the prior art, it appears that "awarding points" would be an obvious variation of "awarding bonuses".

**Dependent Claims 6, 15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chern in view of Angles and further in view of Bezos et al. (US 6,029,141) (Bezoz).**

**As per claims 6, 15 and 20**, Chern and Angles teach all the limitations of claims 6, 15 and 20, except that users receive remuneration for *referring* an unregistered user to receive advertising messages.

Bezoz teaches a method and system for an internet-based customer referral system, wherein registered users receive commissions for referring other users to merchant's site (C. 1, L. 62 – C. 2, L. 18).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern and Angles to include that users receive remuneration for referring an unregistered user to receive advertising messages, as disclosed in Bezoz, because it would advantageously allow advertisers to expose their products to larger audience, thereby increase revenue.

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**Dependent Claims 7, 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chern in view of Angles and further in view of Matsumoto et al. (US 6,484,946) (Matsumoto).**

**Claims 7, 12 and 18.** Chern and Angles teach all the limitations of claims 7, 12 and 18, including that a user account for each registered wireless device is credited for accepting advertising messages (C. 21, L. 19-24), except specifically teaching that said user account is a user *accessible* account.

Matsumoto teaches a method for accessing and displaying information related to electronic money transaction, wherein a user is able to access his account to review confidential information, including points accumulated and redeemed at participating merchants (C. 12, L. 11-18).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern and Angles to include that said user account is a user *accessible* account, as disclosed in Matsumoto, because it would advantageously allow the user to avoid termination of his service for non payment.

#### **Examiner's Note**

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

#### **Response to Arguments**

Applicant's arguments with respect to claims 1-26, 28-33 and 35 have been considered but are moot in view of the new ground(s) of rejection.

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***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

or faxed to:

**(703) 872-9306** [Official communications; including After Final  
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

Igor Borissov  
Patent Examiner.  
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12/07/2004